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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

10/062,102

Applicant(s)

BATES ET AL.

Examiner

Blaine Basom

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The Examiner acknowledges the Applicants' submission on July 29, 2008, amending claims 4, 6, 10, 13, 17, 21, and 23. This Office Action is provided in response to said amendments, and the Applicants' corresponding arguments.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-9, and 14-16 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 5,664,210 to Fleming et al. (hereinafter "Fleming"). In general, Fleming describes a method and system that provides for multiple selections of text while supporting "swipe and type" operations (see e.g. column 2, lines 5-29).

Specifically regarding claim 1, Fleming teaches: selecting a first set of data (e.g. a first "portion" of text) within an application (see e.g. column 7, lines 23-38, and lines 49-67); and selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 7, line 54 – column 8, line 14; and FIG. 5). Fleming thus teaches a method like that of claim 1, which is for selecting multiple sets of data in an application.

As per claim 2, Fleming discloses that the user performs a first predetermined keystroke (i.e. using an “augmentation key”) after selecting a first set of data, wherein the selected keystroke allows the first set of data to remain selected during the selection of a second set of data (see e.g. column 7, lines 64-67; and column 8, lines 34-39).

As per claim 3, Fleming suggests that the selected sets of data can be simultaneously copied and pasted to a predetermined area (see e.g. column 5, lines 47-61; and column 8, lines 25- 33).

As per claim 7, Fleming demonstrates that the data can be text (see e.g. column 7, line 54 – column 8, line 14; and FIG. 5).

As per claim 8, Fleming further teaches de-selecting a selected set of data (see e.g. column 2, lines 22-29).

With respect to claim 9, Fleming teaches: providing an application (e.g. a word processor) for manipulating data (see e.g. column 1, lines 12-23; and column 2, lines 8-22); selecting a first set of data (e.g. a first “portion” of text) within the application (see e.g. column 7, lines 23-38, and lines 49-67); performing a first predetermined keystroke (i.e. via an augmentation key”) after selecting the first set of data (see column 7, lines 64-67); and selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 7, line 54 – column 8, line 14; and FIG. 5). Fleming thus teaches a method like that of claim 9, which is for selecting multiple sets of data in an application.

As per claim 14, Fleming demonstrates that the data can be text (see e.g. column 7, line 54 – column 8, line 14; and FIG. 5).

As per claim 15, Fleming suggests that the above-described method can be implemented via an application (i.e. a word processor) for writing text (see e.g. column 1, lines 12-23; and column 2, lines 8-22). It is apparent that such an application can be applied to write computer code, as is known in the art.

As per claim 16, Fleming further teaches de-selecting a selected set of data (see e.g. column 2, lines 22-29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-6 and 10-13, and 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Fleming, which is described above, and also over PCT Application Publication No. WO 01/29707 A1 to Hussam (hereinafter "Hussam").

Specifically regarding claim 4, Fleming teaches a method like that of claim 1, in which a user can select multiple, non-contiguous sets of data in an application, as is described above (see e.g. the rejection for claim 1). Fleming, however, does not explicitly disclose that the user can further select within the same window of the application from which the selected sets of data were selected, in a distinctive manner, a first portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the portion, as is recited in claim 4. Nevertheless, selecting a portion of a selected set of data is known in the art.

For example, Hussam demonstrates selecting (i.e. highlighting) within an application window multiple sets of data, and whereby the user can further select (i.e. highlight) within the same window of the application, in a distinctive manner (i.e. in a different color highlight), a first portion (i.e. an overlapping portion) of one of the selected sets of data, wherein the one of the selected sets of data remains selected during the selection of the first portion (see e.g. page 6, lines 3-15; page 33, lines 1-29; page 36, line 29 – page 37, line 2; page 44, lines 1-16; and page 54, lines 12-30).

It would have been obvious to one of ordinary skill in the art, having the teachings of Fleming and Hussam before him at the time the invention was made, to modify the application taught by Fleming to include the ability to select portions of already-selected sets of data (i.e. to select overlapping portions), like taught by Hussam. It would have been advantageous to one of ordinary skill to utilize this combination, because a given portion of data can be applicable to

multiple sets, as is suggested by Hussam (see e.g. page 36, line 29 – page 37, line 2). Fleming and Hussam thus teach – to one of ordinary skill in the art – a method like that of claim 4.

As per claim 5, Hussam teaches selecting portions of a selected set of data, i.e. selecting overlapping sets of data (as is described above), which can understandably be applied to select first and second portions of a selected set of data. Hussam, however, does not explicitly disclose that a first portion remains selected during selection of a second portion based upon a predetermined keystroke, or that the selected portions can be manipulated, as is required by claim 5.

Nevertheless, Fleming generally teaches selecting multiple non-contiguous sets of data, and specifically asserts that it is beneficial to allow the user to do so (see e.g. column 1, lines 55-61). Fleming particularly teaches selecting a first set of data, and selecting a second set of data, wherein the first set remains selected during selection of the second set based upon a predetermined keystroke (see e.g. column 7, line 54 – column 8, line 4; and FIG. 5). Moreover, Fleming teaches manipulating the selected sets of data (see e.g. column 5, lines 47-61; and column 8, lines 25- 33).

Consequently, it would have been obvious to one of ordinary skill in the art, having the teachings of Fleming and Hussam before him at the time the invention was made, to further modify the portions taught by Fleming and Hussam such that the user can select the multiple portions based upon a predetermined keystroke, and so that that the user can manipulate the multiple portions, like the selected sets taught by Fleming. It would have been advantageous to one of ordinary skill to utilize this modification, as it provides an efficient means to select multiple portions, and because users often edit selected sets of data, as is suggested by Fleming

(see e.g. column 1, lines 42-61). The above-described combination of Fleming and Hussam thus teach – to one of ordinary skill in the art – a method like that of claim 5.

As per claim 6, Hussam teaches allowing a user to select multiple sets of data, including allowing selection of a second set of data that overlaps a first set of data (see e.g. page 6, lines 3-15; page 33, lines 1-29; page 36, line 29 – page 37, line 2; page 44, lines 1-16; and page 54, lines 12-30). The above-described combination of Fleming and Hussam is thus further considered to teach a method like that of claim 6.

Regarding claim 10, Fleming teaches a method like that of claim 9, in which a user can select multiple, non-contiguous sets of data in an application, as is described above (see e.g. the rejection for claim 9). Fleming, however, does not explicitly disclose that the user can further select, in a distinctive manner, a first and second portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the portions, as is expressed in claim 10. Nevertheless, as described above (see e.g. the rejections for claim 4 and 5), Hussam teaches selecting, in a distinctive manner, a first and second portions of a selected set of data in a same window of the application from which the selected sets of data were selected, wherein the selected set of data remains selected during selection of the first portion and second portions. As further described above (see e.g. the rejections for claims 4 and 5) the combination of Hussam and Fleming also teaches performing a predetermined keystroke, and selecting the second portion of the one of the selected sets of data, wherein the first portion remains selected during the selection of the second portion based upon the predetermined keystroke. Accordingly, the above-described combination of Fleming and Hussam teaches – to one of ordinary skill in the art – a method like that of claim 10.

As per claims 11-12, Fleming suggests that the selected sets of data can be simultaneously copied and pasted to a predetermined area (see e.g. column 5, lines 47-61; and column 8, lines 25- 33). As described above (see e.g. the rejections for claims 4 and 5) the combination of Hussam and Fleming also teaches manipulating selected portions of a selected set of data. Accordingly, the above-described combination of Fleming and Hussam teaches – to one of ordinary skill in the art – a method like that of claims 11-12.

As per claim 13, Hussam teaches allowing a user to select multiple sets of data, including allowing selection of a second set of data that overlaps a first set of data (see e.g. page 6, lines 3-15; page 33, lines 1-29; page 36, line 29 – page 37, line 2; page 44, lines 1-16; and page 54, lines 12-30). The above-described combination of Fleming and Hussam is thus further considered to teach a method like that of claim 13.

Regarding claim 17-19, Fleming teaches: providing an application (e.g. a word processor) for manipulating data (see e.g. column 1, lines 12-23; and column 2, lines 8-22); selecting a first set of data (e.g. a first “portion” of text) within the application (see e.g. column 7, lines 23-38, and lines 49-67); performing a first predetermined keystroke (i.e. via an augmentation key”) after selecting the first set of data (see column 7, lines 64-67); and selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 7, line 54 – column 8, line 14; and FIG. 5). Hussam further teaches selecting, in a distinctive manner, a portion of one of the selected sets of data in a same window of the application from which the selected sets were selected, wherein the one of the selected sets of data remains

selected during selection of the portion, as is described above (see e.g. the rejection for claim 4). Fleming suggests that the selected sets of data can be simultaneously copied and pasted to a predetermined area (see e.g. column 5, lines 47-61; and column 8, lines 25- 33). As described above (see e.g. the rejections for claims 4 and 5) the combination of Hussam and Fleming also teaches manipulating selected portions of a selected set of data. It is thereby apparent that the user can manipulate (e.g. cut, copy, paste, edit) the selected portions after they're pasted. Accordingly, the above-described combination of Fleming and Hussam teach – to one of ordinary skill in the art – a method like that of claims 17-19.

As per claim 20, Fleming demonstrates that the data can be text (see e.g. column 7, line 54 – column 8, line 14; and FIG. 5).

Regarding claim 21, Fleming teaches: selecting a first set of data and a second set of data (e.g. a first and second “portion” of text) within an application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 7, line 54 – column 8, line 4; and FIG. 5). Hussam further teaches selecting, in a distinctive manner, a portion of one of the selected sets of data in a same window of the application from which the selected sets were selected, wherein the one of the selected sets of data remains selected during selection of the portion, as is described above (see e.g. the rejection for claim 4). Moreover, Fleming discloses that such teachings can be implemented as program code stored on a computer recordable medium (see e.g. column 5, lines 9-36). Such program code stored on a computer readable medium for implementing the teachings of Fleming and Hussam is considered a program product like that of claim 21.

As per claim 22, Fleming suggests program code for copying, cutting, pasting, de-selecting, and manipulating selected sets of data (see e.g. column 5, lines 47-61; column 6, lines 9-16; column 6, lines 33-51; and column 8, lines 25-33). The above-described combination of Fleming and Hussam is thus considered to further teach a program product like that of claim 22.

Regarding claim 23, Fleming describes a set selection system for selecting a first set of data and a second set of data (e.g. a first and second “portion” of text) within an application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 7, line 54 – column 8, line 4; and FIG. 5). Hussam further teaches a portion selection system for selecting, in a distinctive manner, a portion of one of the selected sets of data in a same window of the application from which the selected sets of data were selected, wherein the one of the selected sets of data remains selected during selection of the portion, as is described above (see e.g. the rejection for claim 4). The above-described combination of Fleming and Hussam thus teaches – to one of ordinary skill in the art – a system like that of claim 23, which is for selecting multiple sets of data in an application.

As per claim 24, the combination of Hussam and Fleming teaches manipulating selected portions of a selected set of data, as is described above (see e.g. the rejections for claims 4 and 5). The above-described combination of Hussam and Fleming is thus further considered to teach a manipulation system like recited in claim 24.

As per claims 25 and 26, Fleming suggests program code for copying, cutting, pasting, de-selecting, and manipulating selected sets of data (see e.g. column 5, lines 47-61; column 6,

lines 9-16; column 6, lines 33-51; and column 8, lines 25-33). The above-described combination of Fleming and Hussam is thus considered to further teach a system like that of claims 25 and 26.

Response to Arguments

The Examiner acknowledges the Applicants' amendments to claims 4, 6, 10, 13, 17, 21, and 23. Claims 1-26 remain pending.

Regarding independent claims 1, 9, 17, 21, and 23, the Applicants argue that Fleming fails to teach a method comprising selecting a second set of data within an application, wherein a first set of data remains selected during the selection of the second set of data, and wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data, as is claimed. The Applicants submit that Fleming discloses selecting multiple portions of text, whereby the multiple portions of text may be adjacent or non-adjacent to each other. That is, the Applicants appear to agree that Fleming teaches a method comprising selecting a second set of data within an application, wherein a first set of data remains selected during the selection of the second set of data. However, with respect to the limitation, "wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data," the Applicants argue that types of text selection appear to be excluded in Fleming, e.g. overlapping selections, or selections in which one selection is entirely subsumed by another selection. These arguments have been fully considered, but are not persuasive.

The Examiner respectfully asserts that the Applicants have provided too narrow an interpretation of the limitation, “wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data.” This limitation does not necessarily require allowing overlapping selections, or selections in which one selection is entirely subsumed by another selection. If it did require allowing such overlapping selections, there would be no need for e.g. dependent claim 6, which is intended to limit claim 1, and which recites that the method is adapted to allow selection of the second set of data that overlaps the first set of data. Moreover, such an interpretation would lend itself to issues regarding the U.S.C. §112, first paragraph, description requirement. Whereas the specification describes selecting two distinct sets of data, or selecting a portion of an already-selected set of data, there is no description or suggestion within the specification of creating overlapping selections in which a second selection *partially* overlaps a first selection, i.e. a second selection that comprises both a portion of a previously-selected set of data (i.e. a portion of the first selection) and a portion of adjacent, non-previously selected data.

The Examiner further submits that given the broadest, most reasonable interpretation of the limitation, “wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data,” Fleming can be considered to read entirely on said limitation. Fleming discloses that multiple selections can be adjacent or non-adjacent to each other (see e.g. column 8, lines 5-15). Since the text selections are not required to be adjacent to each other, each selection can be considered to be made irrespective of a location of every other selection. Fleming thereby teaches a method comprising selecting a second set of data within an application, wherein a first set of data remains selected

during the selection of the second set of data, and wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data, like claimed.

Regarding claims 4, 10, 17, 21, and 23, the Applicants argue that Habib (U.S. Patent No. 5,694,610 to Habib et al.), cited in the previous Office Action, fails to teach selecting, in a distinctive manner, a portion of one of the selected sets of data in a same window of the application from which the selected sets were selected, wherein the one of the selected sets of data remains selected during the selection of the portion, as is *now* claimed. These arguments have been considered, but are moot in view of the new grounds of rejection presented herein, which are required in response to the Applicants' amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blaine Basom whose telephone number is (571)272-4044. The examiner can normally be reached on Monday through Friday, from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571)272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BTB/
11/21/2008

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